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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181022
Party	Plaintiff American Deli Plus, Inc.
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Date	01/07/2009
Attachments	Motion to Suspend2.pdf (4 pages)(11952 bytes)

In the matter of Application Serial No. 78/755527 for
AMERICAN DELI
Published in the *Official Gazette* on October 2, 2007
(Term for opposition having been extended to
December 3, 2007)

American Deli Plus, Inc.,

Opposer,

V.

Yong Lee and Alexander Lee, d/b/a
Clean Pass of Atlanta,

Applicant.

Opposition No.: 91181022

**OPPOSER AMERICAN DELI PLUS, INC.’S MOTION TO SUSPEND PROCEEDINGS
PENDING DETERMINATION ON DISPOSITIVE MOTIONS**

Pursuant to TBMP 510.03(a), Opposer American Deli Plus, Inc., (“American Deli”) moves the Board to suspend this proceeding pending a ruling on an ostensibly dispositive motion filed on January 6, 2009 by Applicant Yong Lee and Alexander Lee, d/b/a Clean Pass of Atlanta (collectively “Clean Pass”) and a corresponding dispositive motion which Opposer intends to file shortly.

I. PROCEDURAL BACKGROUND

Clean Pass filed an application for registration of the name AMERICAN DELI on November 16, 2005. Clean Pass' application was published on October 2, 2007. American Deli, believing itself to be the senior user of the AMERICAN DELI name and believing that Clean Pass' use of the AMERICAN DELI name in connection with the goods listed in its published

application was likely to cause confusion with American Deli, requested and received and extension of time to oppose. American Deli thereafter filed an opposition to Clean Pass' registration on December 3, 2007.

After a delay in these proceedings caused by Clean Pass' failure to properly answer, this case has proceeded uneventfully. American Deli served written discovery requests on Clean Pass, to which Clean Pass responded.¹ Clean Pass has not served any discovery requests on American Deli. No depositions have been taken. Clean Pass' filed its "Motion to Deny the Opposition to Applicant's Trademark Application," on January 6, 2007.²

II. ARGUMENT

Although there is no provision in the Trademark Rules for a "Motion to Deny," the substance of Clean Pass' Motion indicates that it is in the nature of a motion for summary judgment. Accordingly, American Deli plans to respond to it as such.

American Deli also plans to file its own motion for summary judgment. American Deli will provide undisputed evidence that it and its predecessors in interest have continually used the AMERICAN DELI mark long before Applicant.³ Further, the evidence will also overwhelmingly show that American Deli's products and services, including chicken wings, are sufficiently similar to those listed in Clean Pass' application that likelihood of confusion may also be found as a matter of law.

¹ While Clean Pass filed responses within the required response period, its responses were woefully inadequate. Although American Deli believes that this action may be resolved in its favor on summary judgment even without proper discovery responses from Clean Pass, in the event that the Board denies American Deli's forthcoming Motion for Summary Judgment, American Deli fully intends to file a motion to compel full and proper discovery responses.

² Prior to receiving Clean Pass's "Motion to Deny," American Deli had already planned to file its own Motion for Summary Judgment.

³ American Deli's predecessors have actually used the mark continuously since 1989, a fact which American Deli believes it can prove at trial, if necessary. For the purposes of summary judgment, American Deli will be able to conclusively establish its continuous use as matter of law from 1991—the date the current owner of American Deli began operating the business.

Based on the likelihood that the Board will be able to decide this proceeding at the summary judgment stage and pursuant to applicable law, American Deli respectfully submits that a suspension of all non-germane activities in this proceeding is in the interest of judicial economy and required under the rules. *See* TMBP 510.036 (“When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion.”).

III. CONCLUSION

In light of the forgoing, American Deli respectfully requests that the Board issue and, on order, suspend all actions in this proceeding not germane to the motion to deny and the Motion for Summary Judgment to be filed by American Deli.

Respectfully submitted,

By: /George Tompkins/

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Counsel for Opposer, American Deli Plus, Inc.

Certificate of Service

I hereby certify that a true and complete copy of the foregoing document has been served on all parties to this proceeding by mailing said copy on January 7, 2009, via First Class Mail, postage prepaid to:

Clean Pass of Atlanta
1228 Christiana Crossing
Lawrenceville, GA 30043

/George Tompkins/